

REMARKS

Withdrawal of the Final Rejection and Need for a Prompt Office Action

Applicant has petitioned the Commissioner to withdraw the final rejection, which it is submitted is premature. The petition was mailed September 25, 1995. Applicant confirmed receipt by telephone, although no return postcard submitted with the petition has been received. No response to the petition has been received. As a result, applicant finds it necessary to respond to the Office action without benefit of the response in order to avoid further extension fees.

Need for a Prompt Office Action

Applicant delayed as long as practical in responding to the final Office action in anticipation of receiving consideration of his petition filed September 25, 1995. A prompt action by the Office in response to this amendment, or notification that the finality of the rejection, prior to February 18, 1996 will now be necessary for applicant to retain his procedural options without incurring undue expense in perhaps unnecessarily refiling this application or paying the fee required for reconsideration without refiling. Such prompt action or notification is requested.

Withdrawal of the final rejection is again requested. First, the final rejection in the parent application was made after claims 7-10 were only once rejected. Such a final rejection was premature and improper. No response was made to applicant's objection to the final rejection. Second, the claims in this application were finally rejected in the first action notwithstanding that a new issue was presented by the Rule 132 declaration submitted with the refiled application. Withdrawal of the final rejection is appropriate for the reasons set forth in applicant's petition filed September 25, 1995 and consideration of the petition is requested. The delay in acting on the petition has left applicant in necessary the position of not knowing whether the final

rejection is maintained or not, in responding to the Office action.

Claim Rejections - 35 USC Section 103

Applicant's declaration under Rule 132 was regarded as deficient by the examiner to overcome the rejection of the claims as unpatentable over Bettcher '251 in view of Robins et al. The examiner raised several questions about the declaration. In view of those questions, it is clear that no issue was reached and the applicant should be afforded an opportunity to answer the questions and have the claims reconsidered in the light of the answers without the restrictions imposed by a final rejection.

A Supplemental Declaration Under Rule 132 is submitted herewith setting forth additional facts and clarifying the facts that the examiner questioned. As the declaration makes clear, the core strands of the tested yarns were parallel and the wrapping strands were wound 10 turns per inch. The first wrap was clockwise and the second counterclockwise. It is not clear why this information was regarded as necessary, in that all yarn constructions tested were identical except for the materials being compared. The manner in which the yarn average slash weights were mathematically adjusted to a 1000 denier is set forth in the Supplemental Declaration. Yarns having fibers of different deniers were constructed and tested because the different fibers are not commercially available in identical deniers. Exhibit B to the first declaration and C to the Supplemental Declaration show the test results mathematically adjusted in two different ways to compensate for the different deniers. All of the results, whether adjusted mathematically or not, showed the unexpectedly high cut-resistance of Vectran M, a low-tenacity fiber. While the examiner suggests a different test procedure, the fact that applicant chose the present approach is no reason to question applicant's declaration. Rather, the examiner

should accept applicant's procedures and results for what they are, unless he shows why they are inadequate. As applicant explains in paragraph 5 of the Supplemental Declaration, his test procedure was designed to show the results of using the different high performance fibers alone for core and wraps, the use of different high performance fibers in the core and one wrap in combination with a wire core strand, and in the core and both wraps in combination with a wire core strand. These tests showed the effect of a use of each fiber and compared the effect of Vectran M fiber with that of three known cut-resistant fibers.

The test results demonstrate that Vectran M, which has a much lower tenacity than Spectra had greater cut-resistance. This was particularly surprising and was not to be expected in view of the fact that high cut-resistance has been attributed to high tenacity, a property of the cut-resistant fibers such as Kevlar, Spectra and Vectran HS.

Robins et al. never teaches interchangeability of Vectran M with Kevlar. The trademark Vectran does not indicate the specific nature of the fiber designated by that mark. Just as a mention of a genus does not disclose the species, the broad mention of Vectran is not a disclosure of low tenacity Vectran M or its characteristics. This is particularly true in the context of Robins et al., where "Vectran" is mentioned as a high strength material along with Kevlar and Spectra. See claims 10 and 20, which would lead one away from use of low strength Vectran M and confirm that one skilled in the art would necessarily regard the "Vectran" reference as a referral to high tenacity Vectran HS. Thus, there is no basis for the examiner's statement that the liquid crystal polymer disclosed by Robins et al. would inherently possess the property of tenacity that is no more than 10 grams per denier, a property only of the species Vectran M, especially since cut-resistance was desired.

The examiner states that if Vectran does not inherently possess a tenacity of less than 10 grams per denier, it would have been obvious to use the type of Vectran M fiber that does have that property as a matter of engineering choice to save expense. That is not true. there would be no motivation to choose a low tenacity fiber for high cut-resistance.

The examiner then offers the proposition that when one found there were two Vectrans, it would have been obvious to test both fibers and to choose Vectran M which has slightly less cut resistance and a vastly lower price. First, "obvious to test" is not the standard under Section 103, as the examiner must well know. Second, the examiner cites no prior art disclosing that Vectran M has "slightly less cut resistance" than Vectran HS. The surprising fact attested to by applicant's test results and declarations is that the use of Vectran M provides higher cut-resistance than the high tenacity fiber Spectra and virtually the same cut-resistance as Vectran HS.

Applicant contends that Robins et al. provides no disclosure of Vectran M much less predictability of the high cut-resistance and hence provides no motivation for the substitution of Vectran M for high tenacity synthetic fibers in the Bettcher construction.

The examiner's attention is directed to the recent case of In re Soni, 34 USPQ2d 1684 (Fed. Cir. 1995) holding that "when an applicant demonstrates substantially improved results...and states that the results were unexpected, this should suffice to establish unexpected results in the absence of evidence to the contrary." (Original emphasis.) Applicant's declaration and supplemental declaration show that the claimed low tenacity fiber will produce the improved cut-resistance of high tenacity fibers and rebut any prima facie case of obviousness asserted by the examiner. No contrary evidence is relied upon by the examiner. Thus, it is submitted

the rejection of the claims as obvious over Bettcher in view of Robins et al. must be withdrawn.

Election/Restriction and Claim Rejection - 35 USC Section 112

Reconsideration of the restriction of claims 7-10 from consideration and their rejection under 35 U.S.C. Section 112 is requested.

The examiner's attention is directed to page 3 of the preliminary communication filed in this application. Applicant does not understand why the description on page 6, lines 2-9 does not read on and apply to the structure of Figure 1. If it does, claims 7-10 are not indefinite. Applicant sees no reason why the statement on page 6 must be repeated with the description of each particular embodiment. To require duplicate drawings of a yarn construction merely to support a disclosure that an element of a construction shown can be of a different material is inconsistent with PTO practice. If the examiner regarded the disclosure on page 6, lines 2-9 as describing a patentably distinct embodiment, he should have identified it in the restriction requirement.

To expedite the prosecution, applicant has essentially repeated the text on page 6, lines 2-9, on page 10, after line 19, thereby specifically describing the subject matter of claims 7-10 in connection with Figure 1. It is submitted that claims 7-10 are not indefinite in that they read on the elected species shown in Figure 1 and now described on page 10 in connection with Figure 1.

The examiner has still not explained how claims 7-10 can be withdrawn from consideration, yet finally rejected as indefinite. If the restriction requirement relating to claims 7-10 is not withdrawn, this anomaly should be explained.

Rule 116 Showing

To the extent a showing under Rule 116 is required, applicant submits that the amendments to the specification were not made sooner because the first action was made final and the final rejection in the

7

parent application was made after claims 7-10 were only once rejected. The Supplemental Declaration could not have been submitted earlier, because the final rejection was made based on the original filing of the continuation application. The Supplemental Declaration was required to respond to questions asked by the examiner for the first time in the first Office action. No new issues are raised by this response. Entry and consideration of this response and the Supplemental Declaration submitted in response to the examiner's specific request for clarification is appropriate.

Respectfully submitted,

January 18, 1896
Date

James G. Watterson
James G. Watterson
Reg. No.: 20,180